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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,491	03/19/2004	Ricardo Flores-Lira	1691-15	5687

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EXAMINER

HERTZOG, ARDITH E

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,491

Applicant(s)

FLORES-LIRA ET AL.

Examiner

Ardith E. Hertzog

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2005 and 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 15-18 is/are allowed.
- 6) ☒ Claim(s) 7,13,14 and 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,7 and 13-30 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10 February 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment/Election*

1. This action is in response to the "Reply and Amendment under 37 CFR § 1.111" filed January 25, 2005. Applicant's election of the subject matter of **Group I**, now claims 1, 7 and 13-30 (i.e., species **a.**, per the prior Office action with mailing date November 10, 2004), is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction/election requirement, the election has been treated as an election **without** traverse (see MPEP § 818.03(a)). **Moreover**, all claims to the nonelected species have been **cancelled**. **Thus**, claims 1, 7 and 13-30, per said amendment, drawn to the elected species of **Group I** (i.e., species **a.**) are now pending.

### *Information Disclosure Statement*

2. Receipt is acknowledged of the information disclosure statement (IDS) filed February 10, 2005. As the submission is in compliance with the provisions of 37 CFR § 1.97, the IDS has been considered, in accordance with the enclosed PTO-1449. **However, it is respectfully noted that is it not entirely understood why some of these references have been cited, given the subject matter of this application—specifically:** References A34-36, A44-45, A70, A72 and A101 (drawn to presses/rollers, etc.); References A23, A27, A31, A33 and A69 (drawn to dewatering sludge/deflocculants, etc.); Reference A79 ("Apparatus for Producing UO<sub>2</sub> Powder");

Reference A85 ("Water Hydrolysis Reactor for Making Alumina"); Reference A91 ("Optical Translating System"); Reference A94 ("Manufacture of Arsenic Acid"); Reference A98 ("Controlling Device"); Reference A100 (drawn to a missile); Reference A104 ("Multi-Purpose Chemical Industrial Apparatus"); Reference A106 ("Picture Transmission" (and an equivalent of US 1,849,818)); **and** Reference A111 (from a Chemical Engineering Unit Operations textbook).

### ***Minor Informalities***

3. The disclosure is objected to, because of the following minor informality: in the first line of paragraph [0038], "tertrabasic" should evidently be "tetrabasic". Appropriate correction is required.

### ***Claim Rejections - 35 U.S.C. § 112 & 35 U.S.C. § 101***

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13, 14 and 19-30 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. It is respectfully submitted that these claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.** In particular, it is not seen where the originally filed disclosure

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supports the use of “approximately” to describe **either** applicant’s reaction temperature or reaction time period. **Thus**, since “approximately” at least somewhat broadens the corresponding temperature and time period ranges recited in these claims, with, again, the originally filed disclosure apparently failing to use this term, it must be considered new matter. Deleting all occurrences of “approximately” from claim 13 (upon which claim 14 depends), claim 19 (upon which claims 20-25 ultimately depend), claims 20-21, claim 26 (upon which claims 27-30 ultimately depend), and claims 27, 28 and 30 would overcome this rejection. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claim is considered vague, indefinite, and/or confusing, because it cannot be determined as to **which** statutory class of invention it is drawn. Does applicant intend to claim a composition (i.e., “lead-acid battery paste”) or a process, and if the latter, which one (i.e., “production of lead-acid battery plates” or “production of lead acid batteries”)? Appropriate correction is required.

9. Claim 7 is **also** rejected under 35 U.S.C. § 101, because the claimed invention may be considered directed to non-statutory subject matter. Note that 35 U.S.C. § 101

is drafted so as to set forth the statutory classes of invention **in the alternative only**, while, as just discussed, claim 7 embraces or overlap at least two different statutory classes of invention set forth in 35 U.S.C. § 101 (i.e., composition and process).

Appropriate correction is required.

10. Claims 27-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are considered vague, indefinite, and/or confusing, as follows: The preamble of each of claims 27-29 recites, "The **method** of claim 26" (emphasis added), while the preamble of claim 30 recites, "The **method** of claim 29" (emphasis added). **However**, the preamble of the corresponding independent claim 26 recites, "A lead-acid battery", and is thus a **product** claim (albeit in product-by-process form). Evidently, the first line of claim 26 should **instead** recite, "A method of forming a lead-acid battery comprising:", **and such revision has been presumed for the remainder of this Office action**. Appropriate correction is required.

#### ***Allowable Subject Matter***

11. Claims 1 and 15-18 are considered allowable over the prior art of record.

12. Claims 13, 14 and 19-30 would be allowable **if rewritten or amended to overcome all 35 U.S.C. § 112 rejection(s) set forth above**.

13. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or to have suggested solid state reaction **methods** for the production of tetrabasic lead sulfate via the **specific** sequence of

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reaction steps **required** by instant claim 1 (upon which instant claims 13-14 ultimately depend), as well as **required** by instant claim 19 (upon which instant claims 20-25 ultimately depend) **and presumably required** by independent claim 26 (upon which instant claims 27-30 ultimately depend) – namely, ***the combination of the recited stoichiometric mixture of reactants, reaction temperatures and reaction time periods.*** Accordingly, instant claims 1 and 15-18 in their current form, and instant claims 13, 14 and 19-30 – again, **if** amended/rewritten per paragraph 12. above – must/would be deemed allowable over the prior art of record.

### ***Conclusion***

14. Any inquiry concerning this communication or any earlier communications from the examiner should be directed to Ardith E. Hertzog at telephone number (571) 272-1347. The examiner can normally be reached on Monday through Friday (from about 8:30 a.m. - 4:30 p.m.).

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached at (571) 272-1358. The fax phone number for the organization where this application is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For any

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 AEH

May 1, 2005

  
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